

**REMARKS**

The above referenced application has been reviewed in light of the Office Action mailed September 27, 2006. By the present amendment, in an attempt to expedite allowance of the application, Applicants have cancelled Claims 19, 20, 22 and 26. Applicants expressly reserve the right to pursue the subject matter of Claims 19, 20, 22 and 26 in continuing applications. It is respectfully submitted that the claims presently pending in this application, namely Claims 1-11, 21 and 23-25 do not introduce new subject matter, are fully supported by the application and are patentable over the prior art. Prompt and favorable reconsideration of these claims is earnestly sought.

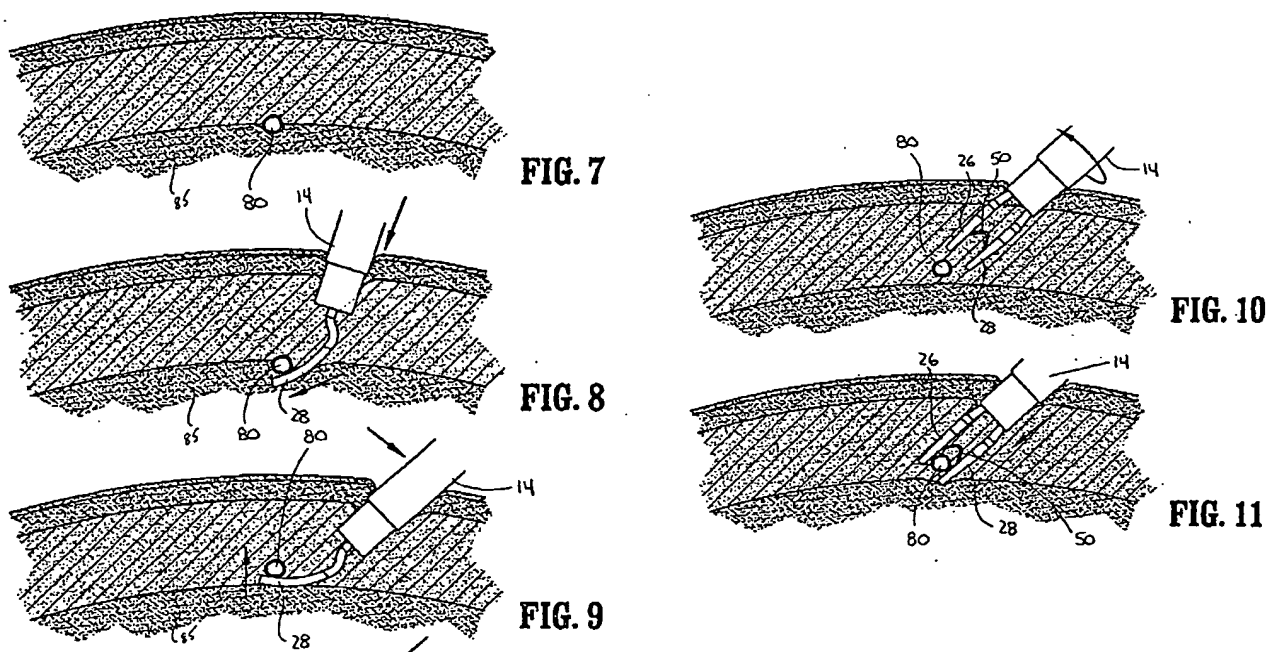
Initially, Applicants respectfully disagree with the Examiner's assertion that Applicants failed to disclose that a curved jaw with a radius of curvature between about .5 inches and about .9 inches provides any advantage, is used for a particular purpose, or solves a stated problem. (Page 3, lines 7-10; page 5, lines 20-23; and page 8 lines 1-3 of the Office Action dated 09/27/2006.) Applicants respectfully submit that a curved jaw with a radius of curvature between about .5 inches and about .9 inches is disclosed in the present application, and that such a configuration provides at least one advantage, is used for a particular purpose and/or solves a stated problem. Particularly, the clip applying apparatus includes a jaw mechanism 16 having a first and second jaw 26 and 28, wherein:

...each first and second jaw 26 and 28 includes a body 26a and 28a, respectively, having a predefined radius of curvature "r" along the longitudinal axis of jaw mechanism 16, such that the distal end of each of jaws 26 and 28 extends upwardly from the longitudinal axis of jaw mechanism 16. In one embodiment, r is from about 0.5 inch (about 12.7 mm) to about 0.9 inch (about 22.7 mm). In another embodiment, r is about 0.7 inch (about 18 mm).

(Paragraph [0031] of published patent application). The description continues at

Paragraph [0035],

Referring to FIGS. 7-11[reproduced hereinbelow], curved jaw mechanism 16 including curved jaws 26 and 28 **provides the advantage of simplifying access to tissue**, e.g., a vessel 80. For example, when a vessel 80 to be ligated is embedded in surrounding tissue 85 or at a location which is difficult to reach, the tips of jaws 26 and 28 can be slid behind or under the vessel 80 (FIG. 8) and manipulated to separate vessel 80 from surrounding tissue 85 and position vessel 80 at a more accessible location (FIG. 8). Thereafter, the position of central body portion 14 and jaw mechanism 16 of clip applying apparatus 10 can be adjusted e.g., rotated 90° (FIG. 10), to position clip 50 about vessel 80. (emphasis added).



Thus, Applicants respectfully submit that curved jaws with a radius of curvature between about 0.5 inches and about 0.9 inches is disclosed in the present application, and that this particular radius of curvature provides at least one advantage, is used for a particular purpose, or solves a stated problem. Specifically, a jaw mechanism including curved jaws with a radius of curvature between about 0.5 inches and about 0.9 inches

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provides the advantage of simplifying access to tissue. As is shown in FIGS. 8 and 9, a clip applying apparatus having curved jaws with a radius of curvature between about .5 and about .9 is advantageous because it enables a user to access and isolate a vessel or other tissue.

In the Office Action, Claims 22 and 26 were rejected under 35 U.S.C. §112, first paragraph. Specifically, the Examiner stated that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application, was filed, had possession of the claimed invention. As noted above, in an attempt to expedite examination, Applicants have cancelled Claims 22 and 26, however, Applicants respectfully disagree with the Examiner's assertion that the limitation of the jaws comprising a "resilient material" is new matter. Specifically, page 6, lines 11-12 of the specification read, "in one embodiment, jaw mechanism 16 is monolithically formed from a suitable surgically approved material such as spring steel." Thus, Applicants submit that a "suitable surgically approved material," and specifically, "spring steel," is disclosed, and therefore the limitation of the jaws comprising a "resilient material" is not new matter.

Claims 22 and 26 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully submit that by the present amendment Claims 22 and 26 have been cancelled, therefore the rejection of claims 22 and 26 should be withdrawn.

Claim 19 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,921,996 to Sherman (hereinafter "Sherman"). As noted above, in an attempt to

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expedite examination, Claim 19 has been cancelled. Therefore, it is respectfully submitted that the rejection of Claim 19 should be withdrawn.

Claims 21 and 23-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,412,539 to Jarvik (hereinafter "Jarvik"). According to the Examiner Jarvik discloses a clip applying apparatus substantially as claimed except does not expressly disclose jaw members having a radius of curvature between about 0.5 inch and about 0.9 inch. The Examiner reasserts that Applicants have not disclosed that this range of values provides any advantage, is used for a particular purpose, or solves a stated problem. As such, the Examiner stated it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide first and second jaws with a radius of curvature between 0.5 inch and 0.9 inch. As discussed above, jaws having a radius of curvature between 0.5 inch and 0.9 inch simplify access to tissue.

As noted above, Applicants respectfully disagree with the Examiner's assertion that no advantage is provided, no particular purpose is defined, and/or no stated problem is solved by jaws having a radius of curvature between 0.5 inch and 0.9 inch.

Claim 21 recites a clip applying apparatus including, inter alia, a jaw mechanism including first and second jaws configured to receive a clip therebetween, the first jaw being movable in relation to the second jaw between open and closed positions, each jaw having a distal end, a proximal end extending out of the body portion, and a lateral edge, wherein from the proximal end to the distal end, the lateral edge moves in a direction spatially oriented from a lower elevation at the proximal end to a higher elevation at the distal end with a radius of curvature "r" of between about .5 inch and about .9 inch.

As stated by the Examiner, Jarvik does not disclose a clip applying apparatus

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including jaw members having "a radius of curvature between about .5 inch and .9 inch."

In light of the argument presented above, Applicants respectfully submit that it would not have been obvious to modify the clip applying apparatus of Jarvik to include jaw members having a radius of curvature of between about .5 inch and about .9 inch. Therefore, claim 21, as originally presented is believed to be in condition for allowance and the rejection of claim 21 should be withdrawn.

Since Claims 23-25 depend from Claim 21 and contain all of the features of claim 21, for at least the reason stated above, inter alia, Claims 23-25 are also allowable over Jarvik.

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,626,586 to Pistl et al. (hereinafter "Pistl") in view of Jarvik and Sherman. As noted above, in an attempt to expedite examination, Claim 20 has been cancelled. Therefore, it is respectfully submitted that the rejection of Claim 20 should be withdrawn.

Claims 1, 2 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,797,959 to Castro et al. (hereinafter "Castro"). According to the Examiner, Castro discloses a clip applying apparatus substantially as claimed except does not expressly disclose jaw members having a radius of curvature between about 0.5 inch and about 0.9 inch. The Examiner reasserts that Applicants have not disclosed that this range of values provides any advantage, is used for a particular purpose, or solves a stated problem. As such, the Examiner stated it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide first and second jaws with a radius of curvature between 0.5 inch and 0.9 inch.

Claim 1 recites a clip applying apparatus including, inter alia, a jaw mechanism

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including first and second jaws configured to receive a clip therebetween, each curved jaw having a radius of curvature "r" of between about .5 inch and about .9 inch. In light of the argument presented above, Applicants respectfully submit that it would not have been obvious to modify the clip applying apparatus of Castro to include jaw members having a radius of curvature of between about .5 inch and about .9 inch. Therefore, claim 1, as originally presented is in condition for allowance and the rejection of claim 1 should be withdrawn.

Since Claims 2 and 7 depend from Claim 1, and contain all of the features of Claim 1, for at least the reason stated above, Claims 2 and 7 are also allowable over Castro.

Claims 1-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pistl in view of U.S. Patent 4,325,376 to Klieman et al. (hereinafter "Klieman").

For at least the reasons stated above, Pistl does not disclose or suggest the clip applying apparatus of Claim 1. Particularly, Pistl does not a clip applying apparatus including, inter alia, a jaw mechanism including first and second curved jaws configured to receive a clip therebetween, each curved jaw having a radius of curvature "r" of between about .5 inch and about .9 inch.

The Examiner relies on Klieman to disclose a jaw mechanism that has upwardly curved jaw members and that curved jaw members provide increased visibility during usage. As noted by the Examiner, Klieman does not disclose a radius of curvature between about 0.5 inches and 0.9 inches. Therefore, Applicants respectfully submit that in view of the arguments presented above, that the rejection of Claim 1, under 35 U.S.C. § 103(a) as being unpatentable over Pistl in view of Klieman, should be withdrawn.


Since claims 2-11 depend from Claim 1, and contain all of the features of Claim 1,

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for at least the reason stated above, Claims 2-11 are also allowable over Pistl in view of Klieman.

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are in the proper format and are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is invited to contact the undersigned at the telephone number listed below with any questions concerning this application.

Respectfully submitted,



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